

HOGAN  
Serial No. 09/932,447

Atty Dkt: 2380-464  
Art Unit: 2681

RECEIVED  
CENTRAL FILE  
JAN 10 2005

### **REMARKS/ARGUMENTS**

Reexamination of the captioned application is respectfully requested.

#### **A. SUMMARY OF THIS AMENDMENT**

By the current amendment, Applicants basically:

1. Editorially amend the specification.
2. Amend the terminating punctuation in claims 18, 27, 45, and 61.
3. Add new claims 70 - 75.
4. Respectfully traverse all prior art rejections.

#### **B. THE REJECTIONS**

Claims 1-62 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-6, 14, 15 and 31-35 of co-pending application USSN 10/068,012.

Claims 21-28 and 63-69 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-6, 14, 15 and 31-35 of co-pending application USSN 10/068,012 in view of U.S. Patent 5,678,184 to Cutler, Jr. et al.

Claims 1-6, 8, 9, 12-13, 15-20, 29, 30, 33, 34, 36, 37 40-41, 43-50, 55, 58, 59, 61 and 62 stand rejected under 35 USC §102(e) as being anticipated by U.S. Publication 2003/0013443 to Willars et al.

#### **C. TRAVERSAL OF REJECTIONS**

Each of Applicants' pending independent method claims 1 and 21 include include a limitation comparable to the following:

HOGAN  
Serial No. 09/932,447

Atty Dkt: 2380-464  
Art Unit: 2681

transmitting from the drift radio network controller (DRNC) to the serving radio network controller (SRNC) a filtering rule for a candidate cell, the filtering rule providing criteria for determining whether the candidate cell qualifies for inclusion in a measurement list of cells for the user equipment unit;

Similarly, each of Applicants' pending independent apparatus claims 29, 48, and 63 include a limitation comparable to the following:

a drift radio network controller (DRNC) ... which transmits to the serving radio network controller (SRNC) a filtering rule for a candidate cell, the filtering rule providing criteria for determining whether the candidate cell qualifies for inclusion in a measurement list of cells for the user equipment unit;

Thus, all independent claims stress that the **drift radio network controller (DRNC) transmits a filtering rule**, and that the filtering rule provides **criteria for determining whether the candidate cell qualifies for inclusion in a measurement list of cells for the user equipment unit**.

Applicants' independent claims are not anticipated by U.S. Publication 2003/0013443 to Willars et al. Willars does not teach or suggest the transmission by the DRNC to the SRNC of a **filtering rule**. As each independent claim clearly states, the filtering rule provides **criteria for determining whether the candidate cell qualifies for inclusion in a measurement list of cells for the user equipment unit**. Thus, the claims and the specification indicate that there is a subsequent determination using the criteria of the filtering rule at a node other than the DRNC node.

In U.S. Publication 2003/0013443 to Willars et al the DRNC may provide an already-filtered list to the SRNC, or a full list of which is filtered at the SRNC by

HOGAN  
Serial No. 09/932,447

Atty Dkt: 2380-464  
Art Unit: 2681

information obtained from the core network<sup>1</sup>, but there is no teaching or suggestion that the a filtering rule (i.e., the filtering criteria that results in a filtered list) being transmitted. As such, Willars does not cater to many of the specialized and unique scenarios covered, e.g., by various ones of Applicants' dependent claims<sup>2</sup>.

In the above regard, please consult Table 1 of U.S. Publication 2003/0013443 to Willars et al., which covers the alternatives disclosed by Willars. Willar's Table 1 is reproduced below with emphasis to reinforce the fact that *Willars does not transmit a filtering rule to the SRNC!*

TABLE 1

| Alt. | Step 1<br>determine | Step 2<br>Filter | Comment  |
|------|---------------------|------------------|--|
| 1    | DRNC                | DRNC             | <ul style="list-style-type: none"> <li>- IMSI of the subscriber is sent from SRNC to DRNC</li> <li>- <i>The DRNC filters using IMSI before returning cell list to SRNC</i></li> </ul>  |
| 2    | SRNC                | DRNC             | <ul style="list-style-type: none"> <li>- The list of allowed areas (e.g., MCC+MNC) of the subscriber is sent from SRNC to DRNC</li> <li>- <i>The DRNC filters using this info and returns filtered cell list to SRNC</i></li> <li>- Requires additions to 3GPP R99 standard, by including a list of allowed areas (e.g., MCC+MNC) of the subscriber in the Iur RNSAP message RADIO LINK SETUP REQUEST</li> </ul> |
| 3    | SRNC                | SRNC             | <ul style="list-style-type: none"> <li>- <i>DRNC returns the full neighbor cell list over Iur to the SRNC</i></li> <li>- The SRNC determines allowed areas of the subscriber and</li> </ul>  |

<sup>1</sup> See alternative 5 in Table 1.

<sup>2</sup> In view of the patentability of the independent claims, Applicant need not now assert separately patentable subject matter in the dependent claims. However, Applicant reserves the right to do so in the future should such become necessary.

HOGAN  
Serial No. 09/932,447

Atty Dkt: 2380-464  
Art Unit: 2681

| Alt. | Step 1<br>determine | Step 2<br>Filter | Comment   |
|------|---------------------|------------------|---|
|      |                     |                  | filters the cell list.  |
| 4    | CN                  | DRNC             | <ul style="list-style-type: none"> <li>- The CN determines the allowed areas (e.g., MCC+MNC) of the subscriber. Two approaches:               <ul style="list-style-type: none"> <li>(1) A configured table in the MSC</li> <li>(2) A record in the HLR for allowed areas of a specific subscriber, which is downloaded to the MSC. (Impact on 3GPP approach: addition of list of allowed areas (e.g., MCC+MNC) to MAP message INSERT SUBSCRIBER DATA)</li> </ul> </li> <li>- The CN passes the allowed areas (e.g., MCC+MNC) to the SRNC over Iu (addition to Iu RANAP message COMMON ID)</li> <li>- <i>SRNC forwards allowed areas over Iur to DRNC and DRNC performs filtering (as in alt. 2)</i></li> <li>- Requires additions to 3GPP approach: Iu, Iur and possibly in CN.</li> </ul> |
| 5    | CN                  | SRNC             | <ul style="list-style-type: none"> <li>- The CN determines the allowed areas (e.g., MCC+MNC) of the subscriber. Two approaches:               <ul style="list-style-type: none"> <li>(1) A configured table in the MSC</li> <li>(2) A record in the HLR for allowed areas of a specific subscriber, which is downloaded to the MSC. Impact on 3GPP approach: addition of list of allowed MCC+MNC to MAP message INSERT SUBSCRIBER DATA)</li> </ul> </li> <li>- <i>The CN passes the allowed areas (e.g., MCC+MNC) to the SRNC over Iu (addition to Iu RANAP message COMMON ID)</i></li> <li>- <i>The DRNC sends the full list of neighbor cells over Iur</i></li> <li>- SRNC performs filtering of the cell list received from the DRNC</li> </ul>  |

HOGAN  
Serial No. 09/932,447

Atty Dkt: 2380-464  
Art Unit: 2681

| Alt. | Step 1<br>determine | Step 2<br>Filter | Comment   |
|------|---------------------|------------------|---|
|      |                     |                  | Requires additions to 3GPP approach: Iu and possibly in CN. |

In view of the foregoing, it is respectfully requested that the rejection under 35 USC §102(e) premised on U.S. Publication 2003/0013443 to Willars et al be withdrawn.

Further, in view of the differing and non-obvious subject matter of the independent claims (as explained above with respect, e.g., to the "filtering rule") and of the myriad dependent claims, Applicants request that the provisional obviousness-type double patenting rejection also be withdrawn.

#### D. MISCELLANEOUS

In view of the foregoing and other considerations, all claims are deemed in condition for allowance. A formal indication of allowability is earnestly solicited.

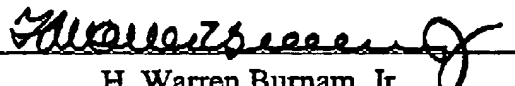
The Commissioner is authorized to charge the undersigned's deposit account #14-1140 in whatever amount is necessary for entry of these papers and the continued pendency of the captioned application.

Should the Examiner feel that an interview with the undersigned would facilitate allowance of this application, the Examiner is encouraged to contact the undersigned.

HOGAN  
Serial No. 09/932,447

Atty Dkt: 2380-464  
Art Unit: 2681

Respectfully submitted,  
NIXON & VANDERHYE P.C.

By:   
H. Warren Burnam, Jr.  
Reg. No. 29,366

HWB:1sh  
1100 North Glebe Road, 8th Floor  
Arlington, VA 22201-4714  
Telephone: (703) 816-4000  
Facsimile: (703) 816-4100

RECEIVED  
COMMUNICATIONS CENTER  
JAN 5 2005